



Paper No. 7

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COPY MAILED

AUG 07 2002

In re Application of : **OFFICE OF PETITIONS**
Mathilde Benveniste :
Application No. 10/032,507 : **DECISION REFUSING STATUS**
Filed: January 2, 2002 : **UNDER 37 CFR 1.47(b)**
Attorney Docket No. 2000-0611 CIP :
For: **RANDOM MEDIUM ACCESS METHODS WITH :**
BACKOFF ADAPTATION TO TRAFFIC :

This is a decision on the petition under 37 CFR 1.47(b), filed April 22, 2002.

The petition under 37 CFR 1.47(b) is **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Failure to respond will result in the abandonment of this application. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(b).

The above-identified application was filed on January 2, 2002, without an executed oath or declaration. Accordingly, a "Notice to File Missing Parts Nonprovisional Application" (the "Notice") was mailed on January 25, 2002, requiring an executed oath or declaration and a surcharge for the late filing of the oath or declaration. The instant petition was filed on April 22, 2002, with a request for an extension of time within the first month pursuant to 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee,
- (4) a statement of the last known address of the non-signing inventor,

- (5) proof of proprietary interest, and
- (6) a showing (statement) that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The instant petition lacks items (1), (2), and (5) as set forth above.

As to item (1), petitioner did not provide sufficient proof that inventor Benveniste refused to sign the declaration after being presented with the a complete copy of the application papers. Section 409.03(d) of the *Manual of Patent Examining Procedure* ("MPEP") provides, in pertinent part, that:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and the refusal must be specified in a statement of facts by the person who presented the inventor with the the application papers and/or to whom the refusal was made.

When there is an express written refusal to join the prosecution of the application], a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

Petitioner indicates that inventor Benveniste expressly refused to sign the declaration, power of attorney, and assignment documents, however; it cannot be ascertained from the statement offered who presented inventor Benveniste with the application papers and to whom the alleged express refusal was made. Further, it cannot be determined from the statement offered whether inventor Benveniste was presented with a complete copy of the application papers as required or only with the Declaration and Power of Attorney and Assignment. In any renewed petition filed, petitioner must take care to provide a statement from the person that presented inventor Benveniste with the application papers and a statement from the person to whom the alleged refusal was made.

As to item (2), petitioner failed to file a proper oath or declaration with the instant petition as required by 37 CFR 1.47. Section 409.03 (b) of the MPEP states, in pertinent part, that:

[t]he 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.54 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person including an attorney or agent authorized to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation.

A review of the application file revealed that petitioner did file a declaration, however, the

declaration was not executed on behalf of the 37 CFR 1.47(b) applicant by an authorized party. Petitioner should refer to MPEP, Section 409.03(b) for further guidance on fulfilling this requirement.

As to item (5), petitioner has not satisfactorily demonstrated that the 37 CFR 1.47(b) applicant, AT&T, has sufficient proprietary interest to proceed with the application on behalf of inventor Benveniste. The *Manual of Patent Examining Procedure*, Section 409.03(f) provides, in pertinent part, that:

[w]hen an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date of the application is deposited in the Patent and Trademark Office,

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the same person having firsthand knowledge of the same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved.

Although petitioner states in the instant petition that inventor Benveniste "... was contractually obligated to assign all her rights to AT&T ..." for inventions that were made during the course of her employment, such as it is alleged of the above-cited invention, petitioner did not provide evidence of such an assignment or written evidence of inventor Benveniste's intention to assign such invention. In the alternative, petitioner failed to provide a legal memorandum, as described above, to establish that AT&T had sufficient proprietary interest to justify the filing of this application. With any renewed petition filed, petitioner must provide an executed assignment, a statement declaring inventor Benveniste's intention to assign her right to the subject invention, or the legal memorandum described above.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

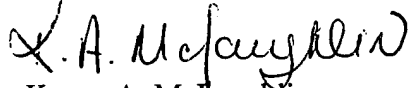
By FAX: (703) 308-6919
 Attn: Office of Petitions

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Telephone inquiries should be directed to the undersigned at (703) 305-0010.



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